



Express Mail No. EV 327053481 US

PHA 4160.1(3202/1)
PATENT

#20
8/15/03
C. Styles

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Application of Michael S. South et al.

Art Unit 1624

AUG 08 2003

Serial No. 09/574,740

Filed May 18, 2000

Confirmation No. 9926

TECH CENTER 1600/2900

For SUBSTITUTED POLYCYCLIC ARYL AND HETEROARYL PYRIDONES

USEFUL FOR SELECTIVE INHIBITION OF THE COAGULATION CASCADE

Examiner T. Truong

August 4, 2003

RESPONSE TO RESTRICTION REQUIREMENT

TO THE COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action mailed on June 27, 2003 in which an election of a Group of claims for prosecution on the merits was requested. The examiner has requested that applicants select from among nineteen different groups of claims asserting that "each group is drawn to a different combination of ring systems that is distinct and patentable over each other." Paper no. 19, page 8. Applicants respectfully traverse this assertion.

According to 35 U.S.C. §121, if two or more independent and distinct inventions are claimed in one application, the Office may require an application to be restricted to one of the inventions. However, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." MPEP §803.

In this instance, the Office failed to make a *prima facie* case that the application contained nineteen independent and distinct inventions. Instead, the Office merely recites that "there are nineteen different independent inventions as compounds of one group can be utilized alone, and not in combination of those with other groups." Paper no. 19, page 8. Even if the application contains more than one independent and

Express Mail No. EV 327053481 US

distinct invention, the Office failed to provide any evidence that searching each invention constitutes an undue burden. Consequently, the Office has failed to make a *prima facie* case for restriction.

Based on the classification of the nineteen groups, it appears that several of these groups may be combined. Specifically, for purposes of searching, applicants submit that the nineteen groups of claims identified by the examiner may logically be placed within the following four categories based upon the classification proved by the Office:

1. claims 17-23 (in part) and 47-57 (in part) classified in class 546 drawn to pyridone compounds of claim 17 having the following characteristics: R^2 is Z^0 -Q wherein Z^0 is a bond and Q is aryl or heteroaryl and Y^0 is phenyl, pyridine, thiophene, oxazole, furan, pyrrole, imidazole, or pyrazole (groups I, V, VI, and X);
2. claims 17-23 (in part) and 47-57 (in part) classified in class 544 drawn to pyridone compounds of claim 17 having the following characteristics: R^2 is Z^0 -Q wherein Z^0 is a bond and Q is aryl or heteroaryl and Y^0 is pyrimidine, pyrazine, or pyridazine (groups II-IV and VII-IX);
3. claims 33-40 (in part) and 47-57 (in part) classified in class 546 drawn to bicyclic core compounds of claim 33 having the following characteristic: Y^0 is phenyl, pyridine, thiophene, oxazole, furan, pyrrole, imidazole, or pyrazole (groups XI, XII, XVI and XIX);¹ and

¹Group XIX is include with the claims of category "3" as possessing a bicyclic core and being in class 546; no definition for Y^0 is provided in group XIX.

Express Mail No. EV 327053481 US

4. claims 33-40 (in part) and 47-57 (in part) classified in class 544 drawn to bicyclic core compounds of claim 33 having the following characteristic: Y⁰ is pyrimidine, pyrazine, or pyridazine (groups XIII-XV, XVII, and XVIII).²

Applicants seek to pursue the claims identified in category 1 above (groups I, V, VI, and X) in this application. If deemed appropriate, applicants reserve the right to pursue the claims identified in categories 2, 3, and 4 in divisional applications.

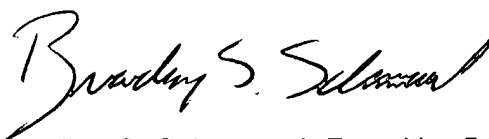
Subject to the foregoing traverse, applicants hereby elect the claims of Group I identified in Paper no. 19.

Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

Enclosed is applicants' check in the amount of \$110 for payment of the surcharge, filing fee and one month extension of time.

Further, the Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

Respectfully submitted,



Bradley S. Schammel, Reg. No. 54,667
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

BSS/vlm
*Enclosure

²Groups XVII and XVIII are included with the claims of category "4" as possessing a bicyclic core and being in class 544; no definitions for Y⁰ are provided in groups XVII and XVIII.